

**REMARKS**

Claims 1, 3-6, 45-58 and 60-65 are pending in this application. Claim 59 has been cancelled. Claims 1, 3-6, 45-58 and 60-65 have been rejected. Claim 61 was objected to. Claims 57 and 61 are amended. In view of foregoing amendments and following remarks, the applicants request allowance of the application.

**Interview Summary of October 24, 2008**

Applicants' representative thanks the Examiner for the courtesies extended during the interview. Applicants' representative asserted that the claim elements were not disclosed or suggested by the cited prior art. The Examiner disagreed and asserted that the prior art did disclose the limitations of the claimed invention.

**Claim Objections**

Claim 61 was objected to due to informalities. "Telephone can support" has been changed to "telephone supports" and "telephone can access" has been changed to "telephone accesses" to comply with the Office Action.

**Claim Rejections under 35 U.S.C. §103**

Claims 1, 3, 5, 6, 46-48, 54, 56-64 are rejected under 35 U.S.C. 103(a) as being unpatentable al. (U.S. Patent No. 5,758,256) (hereinafter "Berry"). Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shankar and Berry further in view of Wilson (U.S. Patent No. 6,169,734 B1) (hereinafter "Wilson"). Claim 65 is rejected as being unpatentable over Shankar in view of Farris (U.S. Patent no. 6,064,653) (hereinafter "Farris").

**Claims 1 and 3-6**

Consider a portion of claim 1, which recites in relevant part:

**determining whether a called party's audio device is able to support said at least one voice compression algorithm \*\*\*  
wherein said determining step is accomplished by exchanging messages between said called party's audio device and said calling party's audio device via a circuit switched network**

The foregoing quoted elements are not disclosed or suggested by the cited prior art. The Office cites the following for disclosing the quoted elements: Shankar at col. 15, lines 7-10, and at col. 15, lines 15-49, and the Office admits that the element for circuit switched network is not

disclosed by Shankar but asserts that Berry teaches a circuit switched network. Office Action, page 6. But, the cited portion of Shankar refers to terminating coding unit (element 150) and originating coding unit (element 110). Refer to FIG. 1 of Shankar. These are not "said called party's audio device" and "calling party's audio device." The terminating coding unit (element 110) and the originating coding units (element 150) of Shankar are described at col. 3, lines 50-64, as signaling units. And, the terminating coding unit and originating coding unit are connected to the originating node 100 and terminating node 160 of Shankar which are described as PBXs, telephone switches, smart phones, wireless PBXs, or legacy telecommunication systems. See Shankar col. 3, line 65 – col. 4, line 3. If any units of Shankar are "called party's audio device" and "calling party's audio device" it is the originating node 100 and terminating node 160 since these are the only elements in Shankar that may include "said called party's audio device." Therefore, the terminating coding unit and the originating coding unit cannot be the called party's audio device and the calling party's audio device.

Further, the originating node 100 and terminating node 160 of Shankar are not exchanging messages to determine a network to use. For example, see FIG. 4 of Shankar where the negotiation that occurs is not between the PBX 100 and PBX 160 but rather between the CU 110 and the CU 150. In fact, it is not until very near the end of the negotiation that an end to end bearer path is established (see FIG. 4 of Shankar). Also, note that Shankar at col. 14, lines 61-63, states that the coding unit and the terminating unit negotiate appropriate compression and decoding levels—not the originating node 100 and the terminating node 160.

Moreover, the method of claim 1 provides for using a first network (circuit switched network) and then switching to a second network (data network) "if said called party's audio device is able to support said at least one voice compression algorithm." See claim 1 and FIG. 1 of Application. Nowhere in Shankar is there a teaching or suggestion of using a first network and then switching to a second network based on support of a compression algorithm. Shankar has two networks illustrated as elements 130 and 132 of FIG. 1, but 130 is a packet switched network and 132 is a signaling network which may be the same as the packet switched network. See Col. 6, Lines 8-10. The signaling network 132 is described as only providing for exchanges of signaling information and not voice information. For example, see col. 5, lines 50-51. Also, note that Shankar at col. 14, lines 61-63, states that the coding unit and the terminating unit

negotiate appropriate compression and decoding levels—not the telephones or originating and terminating nodes.

Additionally, although Berry does have a PSTN element 26 of FIG. 1 (which is being equated by the Office to the circuit switched network of claim 1), the PSTN is not being used by two audio devices to determine whether the audio devices can switch to “a data network, if said called party’s audio device is able to support said at least one voice compression algorithm” as claimed in claim 1. Rather, in Berry two BSC’s 20, 30 (illustrated in FIG. 3) determine the call compatibility as described at col. 4, lines 21-27. The BSC cannot be the called party’s audio device and the calling party’s audio device as they receive signals from the origination and the destination. See Berry, col. 4, lines 21-27. So, in Berry the telephones (which are being equated by the Office with the audio devices of claim 1) are not communicating over the PSTN network to determine whether a data network can be used.

The invention of claim 1 has the advantage that two audio devices can communicate over a circuit switched network to determine whether they can communication over a data network and then switch to the data network if they can communicate over the data network. There is simply no disclosure of this in the cited prior art.

Withdrawal of the rejection of claim 1 is requested. Further, since claims 3-6 depend from claim 1, the rejections of claims 3-6 are traversed for at least the same reasons as for claim 1, and withdrawal of the rejections of claims 3-6 is requested.

#### **Claims 46-48**

Consider a portion of claim 46, which recites in part:

determining, \*\*\* whether the called wireless digital telephone uses a voice compression algorithm that is compatible with a voice compression algorithm used by the calling digital wireless telephone;  
setting up the voice call over the Internet if the called digital wireless telephone and the calling digital wireless telephone use compatible voice compression algorithms; and  
setting up the voice call over the communication network if the called digital wireless telephone and the calling digital wireless telephone use incompatible voice compression algorithms.

The foregoing quoted elements are not disclosed by the cited prior art. As discussed under claim 1, nowhere in Shankar is there a teaching or suggestion of using a first network and then

switching to a second network based on support of a compression algorithm. Berry fails to remedy the deficiencies of Shankar.

Withdrawal of the rejection of claim 46 is requested. Further, since claims 47-48 depend from claim 46, the rejections of claims 47-48 are traversed for at least the same reasons as for claim 46, and withdrawal of the rejections of claims 47-48 is requested.

### **Claims 57-58, 60**

Consider a portion of claim 57, which recites in part:

sending call setup signals via a circuit-switched network to set up a call between a calling party's telephone and a called party's telephone;  
consulting information relating to compatibility of respective voice compression algorithms supported by the calling party's telephone and the called party's telephone; and  
based on the information, sending call setup signals via a data network to complete the call setup, wherein the information is included in a request issued by the calling party's telephone and in a response to the request from the called party's telephone.

The foregoing quoted elements are not disclosed by the cited prior art. As discussed under claim 1, nowhere in Shankar is there a teaching or suggestion of using a first network and then switching to a second network based on support of a compression algorithm. Nor does Shankar teach or suggest switching to a second network (data network) based on information received from the called party's telephone. Berry fails to remedy the deficiencies of Shankar.

Withdrawal of the rejection of claim 57 is requested. Further, since claims 58 and 60 depend from claim 57, the rejections of claims 58 and 60 are traversed for at least the same reasons as for claim 57, and withdrawal of the rejections of claims 58 and 60 is requested.

### **Claims 61-62**

Consider a portion of claim 61, which recites in part:

receiving a response message indicating whether the called digital wireless telephone supports one of the voice compression algorithms on the list •••  
if the response message indicates that the called digital wireless telephone can support one of the voice compression algorithms on the list and that the called digital wireless telephone can access the data network, completing the call setup procedure via the data network; and

if the response message indicates that the called digital wireless telephone cannot support one of the voice compression algorithms on the list or that the called digital wireless telephone cannot access the data network, completing the call setup procedure via the public switched telephone network

The foregoing quoted elements are not disclosed by the cited prior art. As discussed under claim 1, nowhere in Shankar is there a teaching or suggestion of using a first network and then switching to a second network based on support of a compression algorithm. Berry fails to remedy the deficiencies of Shankar.

Withdrawal of the rejection of claim 61 is requested. Further, since claim 62 depends from claim 61, the rejections of claim 62 is traversed for at least the same reasons as for claim 61, and withdrawal of the rejection of claims 62 is requested.

### **Claims 63-64**

Consider a portion of claim 63, which recites in part:

determining, based on a response message from the called digital wireless telephone, whether the called digital wireless telephone supports one of the voice compression algorithms on the list and whether the called digital wireless telephone has access to the data network;

if the called digital wireless telephone supports one of the voice compression algorithms on the list and has access to the data network, completing the call setup procedure via the data network; and

if the called digital wireless telephone does not support one of the voice compression algorithms on the list or does not have access to the data network, completing the call setup procedure via the PSTN

The foregoing quoted elements are not disclosed by the cited prior art. As discussed under claim 1, nowhere in Shankar is there a teaching or suggestion of using a first network and then switching to a second network based on support of a compression algorithm. Berry fails to remedy the deficiencies of Shankar.

Withdrawal of the rejection of claim 63 is requested. Further, since claim 64 depends from claim 63, the rejections of claim 64 are traversed for at least the same reasons as for claim 63, and withdrawal of the rejection of claim 64 is requested.

### **Claim 65**

Consider a portion of claim 65, which recites in part:

establishing the data network talkpath using resources associated with said same data network if said called party's telephone is adapted to exchange voice signals via said same data network; and  
exchanging voice signals between said called party's telephone and said calling party's telephone using the data network talkpath.

The foregoing quoted elements are not disclosed by the cited prior art. As discussed under claim 1, nowhere in Shankar is there a teaching or suggestion of using a first network and then switching to a second network based on support of a compression algorithm. Nor does Shankar teach or suggest exchanging voice signals using a data network if the called party's telephone is adapted to exchange voice signals via said same data network otherwise using an ISUP signaling path. The cited portions of Farris merely disclose a ISUP network and fail to remedy the deficiencies of Shankar. Withdrawal of the rejection of claim 65 is requested.

#### **Claim Rejections under 35 U.S.C. §102**

Claims 49-53 and 55 are rejected under 35 U.S.C. 102(e) as being anticipated by Shankar, et al. (U.S. Patent Number 6,570,869 B1) (hereinafter "Shankar").

#### **Claims 49-52**

Consider a portion of claim 49, which recites in part:

determining whether the calling telephone and the called telephone support compatible voice compression algorithms; and  
diverting the call to a data network if the called telephone supports a voice compression algorithm that is compatible with a voice compression algorithm of the calling telephone.

The foregoing quoted elements are not disclosed by the cited prior art. As discussed under claim 1, nowhere in Shankar is there a teaching or suggestion of using a first network and then diverting to a second network based on support of a compression algorithm.

Withdrawal of the rejection of claim 49 is requested. Further, since claims 50-52 depend from claim 49, the rejections of claims 50-52 are traversed for at least the same reasons as for claim 49, and withdrawal of the rejections of claims 50-52 is requested.

#### **Claims 53-56**

Consider a portion of claim 53, which recites in part:

initiating a call setup between a calling party's audio device and a called party's audio device using a first path;  
before the call setup is completed, determining whether the called party's audio device supports a voice compression algorithm compatible with a voice compression algorithm supported by the calling party's audio device; and based on the determination, completing the call setup using a second path different from the first path.

The foregoing quoted elements are not disclosed by the cited prior art. As discussed under claim 1, nowhere in Shankar is there a teaching or suggestion of using a first network and then switching to a second network based on support of a compression algorithm. Nor does Shankar teach or suggest completing a call setup using a second path different from a first path based on a determination of support of a compression algorithm of a called party's audio device.

Withdrawal of the rejection of claim 53 is requested. Further, since claims 53-56 depend from claim 53, the rejections of claims 53-56 are traversed for at least the same reasons as for claim 53, and withdrawal of the rejections of claims 53-56 is requested.

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**Conclusion**

All outstanding rejections have been overcome. It is respectfully submitted that, in view of the foregoing amendments and remarks, the application is in clear condition for allowance. Issuance of a Notice of Allowance is earnestly solicited.

Although not believed necessary, the Office is hereby authorized to charge any fees required under 37 C.F.R. § 1.16 or § 1.17 or credit any overpayments to Deposit Account No. 11-0600.

The Office is invited to contact the undersigned at 202-220-4200 to discuss any matter regarding this application.

Respectfully submitted,

Date: November 4, 2008

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